

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s): Curry et al.	
Application No.: 09/683,995 (CONF 2530)	Group Art Unit: 2155
Filed: 3/10/2002	Examiner: Khanh Q. Dinh
Title: Email messaging program with built-in video and/or audio media recording and/or playback capabilities	
Attorney Docket No.: 1049.002US1	

Assistant Commissioner for Patents
Washington, D.C. 20231

APPEAL BRIEF

Real party in interest

The real party in interest in this patent application is Talkway, Inc., of Fremont, Calif. All the applicants have assigned their rights in the patent application to Talkway.

Related appeals and interferences

The present patent application was subject to a previous appeal pursuant to the notice of appeal filed on April 11, 2004, a decision regarding which was handed down on March 13, 2007. Responsive to that decision, Applicant filed a request for continuing examination on May 14, 2007, the culmination of which is the present appeal.

Status of claims

Claims 1-24 are pending in the patent application. All the pending claims 1-24 stand finally rejected and are subject to the present appeal.

Status of amendments

Claims 1, 8, 18, 20, and 22 were amended in the office action response of September 13, 2007. The claims as amended were entered and considered by the Examiner in the final office action of November 28, 2007.

Summary of claimed subject matter

There are five pending independent claims in the present patent application: claims 1, 8, 18, 20, and 22.

Independent claim 1

Claim 1 recites a “system” (system 100 of FIG. 1; para. [0024] on p. 5, ll. 13-14). The system includes “a network” (network 106 of FIG. 1; para. [0024] on p. 5, l. 18), “a first client” (client 102 of FIG. 1; para. [0024] on p. 5, l. 14), and “a second client” (client 104 of FIG. 1; para. [0024] on p. 5, l. 14). The first client has “a first email messaging program installed thereon” (email messaging program 110 of FIG. 1; para. [0025] on p. 5, l. 23). A “composing user compos[es] a message on the first email messaging program” (para. [0027] on p. 6, ll. 9-10). Furthermore, the “composing user record[s] media on the first email messaging program” (para. [0027] on p. 6, ll. 9-11). The “first email messaging program send[s] the message and the media to a receiving user over the network” (para. [0028] on p. 6, ll. 18-20; para. [0029] on p. 6, ll. 28-30). The second client has “a second email messaging program installed thereon on which the receiving user receives the message over the network” (para. [0029] on p. 6, l. 28, through p. 7, l. 4). The “second email messaging program play[s] back the media upon the user viewing the message” (para. [0029] on p. 7, ll. 4-7). Importantly, “the first email messaging program sends the message and the media over the network by itself, without having to use any other email messaging program on the first client” (para. [0011] on p. 3, ll. 23-24; para. [0010] on p. 3, ll. 15-17).

Independent claim 8

Claim 8 recites a “system” (e.g., device 500 of FIG. 5; para. [0042] on p. 10, ll. 25-26). The system includes “a networking mechanism communicatively coupling the system to a network” (networking mechanism 506 of FIG. 5; para. [0044] on p. 11, ll. 18-23). The system also includes “an email messaging program” (email messaging program 504 of FIG. 5; para. [0044] on p. 11, ll. 14-15). The email messaging program has “at least a composing capability for a user to compose a message and record media associated with the message to send to another user over the network via the networking mechanism” (capability 602 of FIG. 6; para. [0045] on p. 11, ll. 29-30; para. [0046] on p. 12, ll. 8-10). The “user composes the message on the email messaging program, and the user records the media on the email messaging program” (para. [0044] on p. 11, ll. 14-15; para. [0027] on p. 6, ll. 9-10; para. [0027] on p. 6, ll. 9-11). Importantly, “the email messaging program sends the message and the media over the network by itself, without having to use any other email messaging program on the system” (para. [0011] on p. 3, ll. 23-24; para. [0010] on p. 3, ll. 15-17).

Independent claim 18

Claim 18 recites a “method” (method 200 of FIG. 2A; para. [0031] on p. 7, ll. 17-19). The method recites “saving a message entered by a user by an email messaging program of a system” (part 202 of FIG. 2A; para. [0031] on p. 7, ll. 19-21). The method recites “recording media associate with the message by the email messaging program” (part 204 of FIG. 2A; para. [0031] on p. 7, ll. 23-24). The method recites “uploading the media to a streaming media server over a network by the email messaging program” (part 206 of FIG. 2A; para. [0031] on p. 7, ll. 25-27). The method recites “sending the message over the network by the email messaging program” (part 208 of FIG. 2A; para. [0031] on p. 7, ll. 27-29). The “user composes the message on the email messaging program, and the user records the media on the email messaging program” (para. [0044] on p. 11, ll. 14-15; para. [0027] on p. 6, ll. 9-10; para. [0027] on p. 6, ll. 9-11). Importantly, “the email messaging program sends the message and the media

over the network by itself, without having to use any other email messaging program on the system” (para. [0011] on p. 3, ll. 23-24; para. [0010] on p. 3, ll. 15-17).

Independent claim 20

Claim 20 recites a “method” (method 400 of FIG. 4A; para. [0039] on p. 10, ll. 7-9). The method recites “saving a message entered by a user by an email messaging program of a system” (part 402 of FIG. 4A; para. [0039] on p. 10, ll. 9-11). The method recites “recording media associated with the message by the email messaging program” (part 404 of FIG. 4A; para. [0039] on p. 10, ll. 12-13). The method recites “attaching the media to the message by the email messaging program” (part 406 of FIG. 4A; para. [0039] on p. 10, ll. 13-14). The method recites “sending the message over a network by the email messaging program” (part 408 of FIG. 4A; para. [0039] on p. 10, ll. 14-15). The “user composes the message on the email messaging program, and the user records the media on the email messaging program” (para. [0044] on p. 11, ll. 14-15; para. [0027] on p. 6, ll. 9-10; para. [0027] on p. 6, ll. 9-11). Importantly, “the email messaging program sends the message and the media over the network by itself, without having to use any other email messaging program on the system” (para. [0011] on p. 3, ll. 23-24; para. [0010] on p. 3, ll. 15-17).

Independent claim 22

Claim 22 recites a “computer-readable medium having instructions stored thereon for an email messaging program of a system” (email messaging program 504 of FIG. 6 for device 500 of FIG. 5). The email messaging program includes “means for composing a first message by a first user and for recording first media associate with the first message to send to a second user over a network” (capability 602 of FIG. 6; para. [0045] on p. 11, ll. 29-30; para. [0046] on p. 12, ll. 8-10). The email messaging program further includes “means for viewing a second message received from the second user over the network by the first user, and for playing back second media associated with the second message” (capability 604 of FIG. 6; para. [0045] on p. 11,

ll. 30-31; para. [0046] on p. 12, ll. 12-14). The “first user composes the first message on the email messaging program, and the first user records the first media on the email messaging program” (para. [0044] on p. 11, ll. 14-15; para. [0027] on p. 6, ll. 9-10; para. [0027] on p. 6, ll. 9-11). Importantly, “the email messaging program sends the first message and the media over the network by itself, without having to use any other email messaging program on the system” (para. [0011] on p. 3, ll. 23-24; para. [0010] on p. 3, ll. 15-17).

Grounds of rejection to be reviewed on appeal

There is one ground of rejection to be reviewed on appeal: whether the US patent reference Budge et al. (US Pat. No. 6,564,248) anticipates the claimed invention of pending claims 1-24 under 35 USC 102(e).

Argument

In this argument, independent claim 1 is discussed as representative of all the independent claims 1, 8, 18, 20, and 22. Claim 1 recites the limitation that “the first email messaging program sends the message and the media over the network by itself, without having to use any other email messaging program on the first client”; substantially identical limitations are found in the other independent claims 8, 18, 20, and 22. Applicant submits that this limitation in particular is not found in or disclosed by Budge.

The standard for anticipation under 35 USC 102 is that every aspect of a claim must identically appear in a single prior art reference for it to anticipate the claim. (In re Bond, 15 USPQ2d 1566 (Fed. Cir. 1990)) “T]here must be no difference between the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in the field of the invention.” (Scripps Clinic & Research Found. v. Genentech, Inc., 18 USPQ2d 1001, 1010 (Fed. Cir. 1991)) Applicant submits that Budge does not anticipate the claimed invention under this standard.

The Examiner has relied on the video e-mail software 50 of Budge as corresponding to the email messaging program of the claimed invention. (See, e.g., final office action of November 28, 2007, p. 2, para. 3, in which the first email messaging program of the invention is correlated to element 50 of FIG. 1 in Budge.) However, the software 50 in Budge only permits a user to record media – and it does not send the message with the recorded media “over the network by itself, without having to use any other email messaging program,” in contradistinction to the claimed invention. For instance, Budge discloses that “the sending system PC 10 executes video e-mail software 50 which provides for the creation of video e-mail messages *and the transfer of those messages to a conventional e-mail client.*” (Col. 3, ll. 37-42.) Thus, in Budge, what occurs is that a user creates a video e-mail message within the software 50, which is one computer program. The video e-mail software 50 then sends this message to another computer program – a conventional e-mail client – which then sends the video e-mail message over the network.

That is, the difference between Budge and the claimed invention is this: in the claimed invention, the first email messaging program on which a user records media and on which the user composes a message *is also the same program that sends the message and the media over the network, by itself, without having to use any other email messaging program.* By comparison, in Budge, the software 50 on which a user records media and on which the user composes a message is **NOT** the same program that sends the message and the media over the network – rather, a *different computer program – the conventional e-mail client – is the program that actually sends the message and the media over the network.* The claimed invention provides for functionality in one computer program, in other words, that Budge divides over two different computer programs.

For this reason, Applicant submits that Budge does not disclose the identical invention that has been claimed, and therefore does not anticipate the claimed invention.

Curry et al.
Serial no. 09/683,995
Filed 3/10/2002
Attorney docket no. 1049.002US1

Page

Respectfully Submitted,

A handwritten signature in black ink, appearing to read "Michael Dryja", written over a horizontal line.

Michael Dryja, Reg. No. 39,662
Attorney/Agent for Applicant(s)

4-29-2008
Date

Michael Dryja, Esq.
Law Offices of Michael Dryja
1474 N Cooper Rd #105-248
Gilbert, AZ 85233

tel: 425-427-5094
fax: 425-563-2098

Listing of claims on appeal

1. (previously presented) A system comprising:
a network;
a first client having a first email messaging program installed thereon, a composing user composing a message on the first email messaging program, the composing user ~~and~~ recording media on the first email messaging program, the first email messaging program sending the message and the media to a receiving user over the network; and,
a second client having a second email messaging program installed thereon on which the receiving user receives the message over the network, the second email messaging program playing back the media upon the user viewing the message,
wherein the first email messaging program sends the message and the media over the network by itself, without having to use any other email messaging program on the first client.
2. (original) The system of claim 1, further comprising a streaming media server, the first email messaging program uploading the media to the streaming media server upon the message being sent to the receiving user over the network, and the second email messaging program downloading the media from the streaming media server over the network upon the receiving user viewing the message.
3. (original) The system of claim 1, wherein the first email messaging program attaches the media as an attachment to the message upon the message being sent to the receiving user over the network, and the second email messaging program receives the media as the attachment to the message over the network.

4. (original) The system of claim 1, wherein the network comprises at least one of: the Internet, an intranet, an extranet, a local-area network (LAN), a wide-area network (WAN), a wired network, a wireless network, and a telephony network.
5. (original) The system of claim 1, wherein each of at least one of the first client and the second client comprises: a desktop computer, a laptop computer, a cellular phone, a wireless phone, a set-top box, and a personal digital assistant (PDA) device.
6. (original) The system of claim 1, wherein the message comprises at least text.
7. (original) The system of claim 1, wherein the media comprises at least one of: audio, video, streaming audio, and streaming video.
8. (previously presented) A system comprising:
a networking mechanism communicatively coupling the system to a network; and,
an email messaging program having at least a composing capability for a user to compose a message and record media associated with the message to send to another user over the network via the networking mechanism,
wherein the user composes the message on the email messaging program, and the user records the media on the email messaging program, and
wherein the email messaging program sends the message and the media over the network by itself, without having to use any other email messaging program on the system.
9. (original) The system of claim 8, further comprising an operating system on which the email messaging program runs.

10. (original) The system of claim 8, wherein the composing capability uploads the media to a streaming media server communicatively coupled to the network over the network via the networking mechanism upon the message being sent to the other user over the network via the networking mechanism.

11. (original) The system of claim 8, wherein the composing capability attaches the media as an attachment to the message upon the message being sent to the other user over the network

12. (original) The system of claim 8, wherein the email messaging program further has a playback capability for the user to view messages received from other users over the network via the networking mechanism and play back received media associated with the messages received.

13. (original) The system of claim 12, wherein the playback capability downloads the media associated with one of the messages received from the streaming media server over the network via the networking mechanism upon the user viewing the one of the messages received.

14. (original) The system of claim 12, wherein the playback capability receives the media associated with one of the messages as an attachment to the one of the messages received over the network.

15. (original) The system of claim 8, wherein the networking mechanism comprises at least one of: an analog modem, an Integrated Services Digital Network (ISDN) adapter, a network adapter card, a network adapter chipset, a cable modem, a Digital Subscriber Loop (DSL) modem, a digital modem, and a wireless modem.

16. (original) The system of claim 8, wherein the message comprises at least text.

17. (original) The system of claim 8, wherein the media comprises at least one of: audio, video, streaming audio, and streaming video.

18. (previously presented) A method comprising:
saving a message entered by a user by an email messaging program of a system;
recording media associated with the message by the email messaging program;
uploading the media to a streaming media server over a network by the email messaging program; and,
sending the message over the network by the email messaging program,
wherein the user composes the message on the email messaging program, and the user records the media on the email messaging program, and
wherein the email messaging program sends the message and the media over the network by itself, without having to use any other email messaging program on the system.

19. (original) The method of claim 18, further comprising:
receiving a second message over the network by the email messaging program;
in response to a user requesting the email messaging program to display the second message,
displaying the second message by the email messaging program;
downloading second media associated with the message from the streaming media server over the network by the email messaging program; and,
playing back the second media by the email messaging program.

20. (previously presented) A method comprising:
saving a message entered by a user by an email messaging program of a system;
recording media associated with the message by the email messaging program;
attaching the media to the message by the email messaging program; and,

sending the message over a network by the email messaging program,
wherein the user composes the message on the email messaging program, and the user records the media on the email messaging program,
wherein the first email messaging program sends the message and the media over the network by itself, without having to use any other email messaging program on the system.

21. (original) The method of claim 20, further comprising:
receiving a second message having attached thereto second media over the network by the email messaging program;
in response to the user requesting the email messaging program to display the second message,
displaying the second message by the email messaging program; and,
playing back the second media by the email messaging program.

22. (previously presented) A computer-readable medium having instructions stored thereon for an email messaging program of a system, the email messaging program comprising:
means for composing a first message by a first user and for recording first media associated with the first message to send to a second user over a network; and,
means for viewing a second message received from the second user over the network by the first user, and for playing back second media associated with the second message,
wherein the first user composes the first message on the email messaging program, and the first user records the first media on the email messaging program, and
wherein the email messaging program sends the first message and the media over the network by itself, without having to use any other email messaging program on the system.

23. (original) The medium of claim 22, wherein the means for composing and for recording uploads the first media to a streaming media server communicatively coupled to the network over

the network upon the first message being sent to the second user over the network, and the means for viewing and for playing back downloads the second media from the streaming media server over the network upon the first user viewing the second message.

24. (original) The medium of claim 22, wherein the means for composing and for recording attaches the first media as an attachment to the first message upon the first message being sent to the second user over the network, and the means for viewing and for playing back receives the second media as an attachment to the second message over the network.

Evidence Appendix

(No evidence was submitted pursuant to Rules 130, 131, and 132, and therefore, this section is blank.)

Related Proceedings Appendix

(There are no related proceedings to this patent application, and therefore, this section is blank.)